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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/689,658	10/22/2003	Stuart Weikel	001227.0092	6494
69095 7590 02/13/2008 STROOCK & STROOCK & LAVAN, LLP 180 MAIDEN LANE NEW YORK, NY 10038				
EXAMINER				
PHILOGENE, PEDRO				
ART UNIT		PAPER NUMBER		
3733				
MAIL DATE		DELIVERY MODE		
02/13/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/689,658

**Applicant(s)**

WEIKEL ET AL.

**Examiner**

Pedro Philogene

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-23 and 25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23, 25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/29/07 has been entered.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6,12,17-23,25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoon (5,676,683) in view of Swindle et al (5,893,865).

With respect to claims 1 and 25, Yoon disclose a surgical instrument or probe sleeve comprising a shaft (34,36) having longitudinal axis and proximal and distal ends having a length sufficient to create a percutaneous path to bone, a cross-section normal to the longitudinal axis, a first bevel (160) located at a first position adjacent to the distal end of the shaft or the tubular shaft of the probe sleeve and extending towards the proximal end at a first angle relative to the longitudinal axis, a second bevel (160) located at a second position adjacent to the first position and extending towards the proximal end of the shaft or probe sleeve at a second angle relative to the longitudinal

axis that is different from the first angle, the first and second bevels forming a plurality of surfaces; as set forth in column 9, lines 59-67, column 10, lines 1-21, column 11, lines 52-67, column 12, lines 1-7 and as best seen in FIGS.7,8,18. A probe (32) having a probe shaft having proximal and distal ends, the probe shaft having a probe handle (38) on the proximal end of the probe shaft, the probe shaft being sized to be insertable into the hole, as best seen in FIG.1, in the proximal end of the sleeve handle (38) and the probe handle (38) being sized larger than the hole in the sleeve handle (38) so as to prevent the probe handle from passing entirely through the hole in the sleeve handle.

It is noted that Yoon teaches of a tip having a plurality of facets that intersects to form a point for piercing tissue, at least two of the facets intersecting to form an edge for cutting tissue, and at least one other surface adjoining the cutting edge. However, it is noted that Yoon did not teach of a tip wherein the tip has a first cross-section at the first location having a first area and a second cross-section at a second location having a second area, the first area greater than the second area, and the second location is situated between the first location and the proximal end of the shaft; as claimed by applicant. However, Swindle et al., column 3, lines 57-67, and FIGS.1-10, evidences the use of a tip with such characteristics to provide a cutting head, which cuts very efficiently, thereby reducing trauma to the patient.

Therefore, given the teaching of Swindle et al, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the head of the device of Yoon, as taught by Swindle et al to provide a cutting head which cuts very efficiently, thereby educing trauma to the patient.

With respect to claims 2-6, 12, 17-23, the above combination of references teaches all the limitations, as set forth.

Claims 7-11, 18-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoon (5,676,683) in view of Swindle et al (5,893,865) in view of Gelpcke (1,852,296).

It is noted that the above combination of references did not teach of a plurality of surfaces aligned with the longitudinal axis; as claimed by applicant. However, in a similar art, Gelpcke, evidences the use of a device, having a plurality of surfaces aligned with the longitudinal axis for preventing the shaft from turning inside a bore.

Therefore, given the teaching of Gelpcke, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Yoon/Swindle et al as taught by Gelpcke, to prevent the device from turning inside the sleeve.

### ***Response to Amendment***

Applicant's arguments, see Remarks, filed 11/29/07, with respect to the rejection(s) of claim(s) 1-23,25 under 103 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Yoon. Yoon discloses that facets (160) correspond to the facets (140) of the trocar tip; and the trocar tip can have any number of facets arranged at regular or irregular positions. And, in accordance with the modification of the present invention of FIGS.7, 8, the shaft will have a number of facets equal to and similarly arranged with the trocar facets to produce a continuous

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profile during penetration. Since the trocar tip can have any number of facets arranged at regular or irregular positions, it is, therefore, obvious that the angle of one regular facet with respect to another irregular facet would be different relative to the longitudinal axis.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

5,868,773	2-1999	Danks et al.
6,162,236	12-2000	Osada

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pedro Philogene whose telephone number is (571) 272-4716. The examiner can normally be reached on Monday to Friday 6:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272 - 4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Pedro Philogene/  
Primary Examiner, Art Unit 3733  
February 12, 2008